

associated binding for assembly of said sole to an element such as a ski, cycle pedal, etc., said insert being duplicate molded in said rigid intermediate layer [9)] (9).

27. (Amended) Sole according to claim 21, wherein said intermediate layer[, or rib] (9F) [can] is adapted to allow mechanical attachments of studs in a screw-in configuration in an application to golf shoes.

REMARKS

Favorable reconsideration of the present application is respectfully requested.

Claims 1-28 and 30-32 remain active in the application, of which Claims 28 and 30-32 represent new claims which were not present in the issued patent. Claims 1-28 and 30-32 all stand rejected.

I. REISSUE RECAPTURE ESTOPPEL

Applicants note the withdrawal of the rejection based upon reissue recapture estoppel.

II. REJECTION UNDER 35 U.S.C. § 112

Applicants note the withdrawal of the rejection based upon 5 U.S.C. § 112, first paragraph.

Concerning the rejection under 35 U.S.C. § 112, second paragraph (paragraph 1 of the Office Action), it is again noted that Claims 17, 19 and 24 were original claims and represent

original disclosure. Therefore, the phrase "entire" as added during prosecution, must be understood by those skilled in the art as taking into account features corresponding to those of Claims 17, 19 and 24.

Concerning the rejection of Claim 22 under 35 U.S.C. § 112, second paragraph, the examiner has not explained why the claimed zones are would be so unclear to those skilled in the art that they could not understand the metes and bounds of the invention. In this regard, the examiner is respectfully reminded that:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. (MPEP § 2173.02).

Claim 23 has been amended to replace "latter" with "intermediate layer." Claims 26 and 27 have been amended to recite that the intermediate layer is adapted to allow mechanical attachment of the recited elements. The rejection under 35 U.S.C. § 112, second paragraph is therefore believed to be moot.

III. PRIOR ART REJECTIONS

[Paragraph 3] Claim 28 was again rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patent to Tong et al. Claim 28 recites that the intermediate layer

extends "over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe." As was previously explained, there is no teaching for this structural feature of Tong et al.

For example, the insert member 56 in Tong et al extends only in the heel area of the sole (see Fig. 4). It is thus not present at the fore half of the sole. Even a cursory examination of Tong et al thus indicates that the insert member 56 extends over *less than one half* of the ground contact layer which is located directly beneath a foot of a person wearing the shoe.

The insert member 120 of Tong et al (Figure 16) is also limited and has significant spaces between the lateral extensions at the heel and between the fingers 122, and so the above remarks regarding insert member 56 apply here as well, i.e., it is limited in extent and cannot reasonably satisfy the plain meaning of an intermediate layer which extends "over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe."

As a separate matter, the insert member 120 of Tong et al, due to its shape (Fig. 16), cannot provide torsional rigidity. This is especially clear from the presence of the long slots between the fingers 122 in Fig. 16. The fingers 122 are a part of an extending portion 124 whose purpose is instead to return energy (col. 4, lines 34-35). The slots permit the fingers to bend individually, and so they are incapable of providing torsional rigidity. Indeed: "Extending portion 124 is a feature which increases overall cushioning of the sole *but does*

not otherwise affect the operation of the remaining portion of the insert member 120" (col. 9, lines 50-53; emphasis added). Tong et al thus discloses the opposite of what is claimed and so cannot anticipate any of the claims.

The examiner, in paragraph 12 of the present Office Action, has asserted that Tong et al may justifiably be interpreted to disclose an intermediate layer which extends "over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe" because there is no guidance in the specification as to what is meant by "substantially an entire." However, it is noted that the specification need not explicitly define what is encompassed by "substantially." It is only necessary that one of ordinary skill in the art would know what is meant thereby. MPEP § 2173.05(b). Here, the required guidance is provided by the description in the specification. Nothing in the specification suggests in any way that "substantially an entire" could include the partial insert member 120 of Tong et al.

Indeed, the examiner has interpreted the recited intermediate layer which extends "over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe" *to have the same meaning as* an intermediate layer which extends "over at least a part of" said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe. In doing so, the examiner has improperly read the phrase "substantially an entire" out of the claim, or at least has failed to give it even its broadest reasonable interpretation (i.e., plain meaning).

[Paragraph 4] Claim 28 was also rejected under 35 U.S.C. § 102 as being anticipated by Barry et al. As previously explained, however, the spring plate 17 of Barry et al. is not present at the lateral part of the heel, and so also does not correspond to the plain meaning of an intermediate layer which extends “over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe.” Thus the broadest reasonable interpretation of this claim term is not taught by Barry et al.

As a separate matter, Barry et al. does not require torsional stiffness. Instead, Barry et al. teaches minimizing torsional stiffness so as not to increase the degree and rate of pronation and the potential for injury (col. 5, lines 5-11). Barry et al. thus provides the insert for a spring effect and to cooperate with the viscous midsole (col. 3, lines 10-19). Accordingly, Barry et al. teaches away from the claimed invention.

As with the rejection based on Tong et al., the examiner’s response in paragraph 12 has improperly read the phrase “substantially an entire” out of the claim, or at least has failed to give it even its broadest reasonable interpretation.

[Paragraph 5] Claims 30-32 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. patent 5,025,573 (Giese), the examiner alleges that Giese shows a shoe including “a comfort layer” in the elements above element 31. However, the specification of Giese does not describe any elements whatsoever above the main bar 31 in these figures, nor are any such overlying elements illustrated in Figures 122-126 of the reference. *The noted*

lines 1-33 of col. 10, moreover, do not refer to these figures but to Figures 83-99 which do not include main bar 31. Applicants therefore fail to find a basis in the reference for this rejection.

[Paragraph 6] Claims 1, 2, 14-16, and 24 were rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patent to Fukuoka. However, this rejection is respectfully traversed. Fukuoka is directed to a sandal, not a sport shoe, and so is not material to the claimed invention. Moreover, regardless of whether a sandal can be a sport shoe, Fukuoka lacks the combination of a ground contact layer, a cushion layer and an intermediate layer. Rather, in Fukuoka a *hard* core layer 17 is laid on a soft ground contact layer 15, and projections 29, 31 and 33 of the ground contact layer pass through holes of the core layer to lock the two layers together. The Examiner alleges that projections 29, 33 and 31 form a cushion layer. However, the projections 29, 33 and 31 are themselves provided with (hard) cores 30, 32 and 34 (col. 5, lines 15-16), to provide stimulation and not comfort. *The examiner's allegation in paragraph 12 of the Office Action that these elements nonetheless provide cushioning thus contradicts this description of stimulation.* Thus the projections 29, 33 and 31 cannot provide a cushion layer and Fukuoka does not anticipate any of the claims.

[Paragraph 7] Claims 1, 19, 20 and 25 were also rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patent to Salzman. The Examiner there alleges that the insert 30 of Salzman comprises an intermediate layer which covers the entire ground contacting

surface. However, Applicants fail to understand the basis for this allegation. It is the ground contact layer in Salzman which is rigid, not the insert. Also, there is no description of the extent of the insert 30 in the specification of Salzman, other than that it provides an arch portion intermediate front and rear portions (column 3, lines 3-6). There is, in particular, no description in the specification that the insert 30 extends over the entire surface of the ground contact layer. Nor is this taught by the figures. The sectional view of Figure 2 is limited to a single plane; it provides no teaching regarding the extent of the insert 30 on either lateral side of the plane of the figure. *Moreover, despite the assertion in paragraph 12 of the Office Action, neither of Figures 3 and 6 of the reference shows the insert 30.* Thus, the insert 30 could be significantly limited and is not taught to extend over the entire surface of the ground contact layer.

Claim 1 further recites that the ground contact layer is made of rubber. Salzman, on the other hand, is a molded ski boot having a molded plastic ground contact layer which is explicitly described as having better torsional rigidity than rubber (col. 1, line 40), i.e., *it teaches against the use of rubber.* The claims thus define over this reference.

[Paragraph 9] Claims 1, 17, 18, 28 and 30-31 were rejected under 35 U.S.C. § 103 as being obvious over Misevich in view of Giese. Initially, it is noted that the plate 37 of Misevich is buried in the mid-sole 44-46, and so is not in contact with the ground contacting layer. Moreover, the plate 37 of Misevich et al has a limited extent. In apparent recognition of this fact, the Examiner has alleged it would have been obvious in view of Giese to extend

the plate 37 of Misevich into the metatarsal area and to form a series of rigid inserts.

However, even if this were indeed obvious to those skilled in the art, no combination of the above references would have rendered obvious the subject matter of the rejected claims.

For example, Claim 1 recites that the intermediate layer extends over an entire surface of the ground contact layer. While, as already noted, the word "entire" must be understood in light of the original disclosure, including Claims 17, 19 and 24, the main bar 31 of Giese extends only over the central portion of the heel, and not to the rear or lateral sides. Moreover, the flex bars 31A are completely separate from the main bar 31 and are themselves limited to the center portion of the sole. Indeed the main bar 31 and flex bars 31A of Giese extend over only about one half of the sole area and cannot conform to the plain meaning of an intermediate layer extending over an entire surface of the ground contact layer (Claim 1) or any reasonable interpretation of an intermediate layer extending over substantially the entire surface of the ground contact layer (Claims 28, 30 and 31).

[Paragraph 10] Claims 1, 2, 4-14, 21-23 and 25-28 were rejected under 35 U.S.C. § 103 as being obvious over Misevich in view of either the U.S. patent to Hannibal and to Kurrash. Again, in evident recognition of the limited extent of the plate 37 of Misevich, the Examiner has relied upon either Hannibal or Kurrash to suggest extending the stiffening layer to cover the entire surface of the ground contact layer. However, this is also respectfully traversed.

Element 36 of Kurrash et al is merely a mid-sole. While the examiner has noted that it is described as being made from a “relatively” hard elastomeric material, the extent of this hardness is not further described (i.e., hard in relation to what?), nor is its thickness (it is illustrated as being thin, and so flexible). There is thus no basis for concluding that it has a controlled torsional and flexional rigidity. Indeed, the description in Kurrash et al of stitching 46 (a rigid material is not susceptible to stitching) and the need for a *separate* cross bar *stabilizer* 48 (column 3, lines 6-10) suggests that the element 36 lacks torsional and flexional rigidity. The mid-sole 36 of Kurrash et al thus cannot suggest an intermediate layer in Misevich which has a controlled torsional and flexional rigidity.

The element 30 of Hannibal is simply an inner sole, and not a reinforcement. Also, it is separated from the comfort layer and is not arranged directly between the comfort layer and the ground contact layer. As for the examiner’s assertion in paragraph 12 of the Office Action that the exact placement of the layer 30 in Hannibal not taught to be exclusive to the location disclosed, Hannibal *nonetheless fails to suggest a reinforcement arranged directly between the comfort layer and the ground contact layer*. Thus, no combination of the above references would anticipate or render obvious the subject matter of any of the claims.

[Paragraph 11] Claim 3 was rejected under 35 U.S.C. § 103 as being obvious over any of the previously applied references, and further in view of Banich, which was cited to teach providing a mid-sole having zones of different material properties. However, whatever teaching Banich may have in this respect, it would not overcome the shortcomings of the

Serial No.: 09/994,059

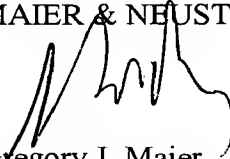
Reply to Office Action dated November 7, 2003

primary references as discussed above, and so no combination of the above references would have rendered obvious the subject matter of any of the claims.

Applicants therefore believe that the present application is in a condition for allowance and respectfully solicit an early notice of allowability.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Robert T. Pous
AttorneyS of Record
Registration No. 29,099

Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413 -2220
(OSMMN 08/03)

GJM:RTP:tdm
I:\ATTY\RTP\216196US-AM5.DOC

216196US30 RE

MARKED UP COPY

IN THE CLAIMS

Please amend the claims as follows:

23. (Amended) Sole according to claim 1, wherein said ground-contact layer (7B) is formed from skids mounted externally on said intermediate layer (9) in recesses (20) provided in the [latter] intermediate layer for that purpose.

26. (Amended) Sole according to claim 1, wherein said rigid intermediate layer(9) [can] is adapted to allow mechanical attachment of an insert cooperating with an associated binding for assembly of said sole to an element such as a ski, cycle pedal, etc., said insert being duplicate molded in said rigid intermediate layer (9).

27. (Amended) Sole according to claim 21, wherein said intermediate layer (9F) [can] is adapted to allow mechanical attachments of studs in a screw-in configuration in an application to golf shoes.